

R E M A R K S

Claims 1, 15, 24, and 26-28 are amended. Claim 12 is canceled. Claims 2-11, 13, 14, 16-23, 25, and 29-31 stand as originally filed. Re-examination and reconsideration are requested.

In the office action, paper number (unspecified), dated September 27, 2005, the examiner rejected claims 1, 5, 14, 15, 23, 24, and 26-31 under 35 U.S.C. §102(b) as being anticipated by Rudd, et al., U.S. Patent No. 6,934,915 (Rudd). The examiner rejected claims 2-4, 6-13, 16-22, and 25 under 35 U.S.C. § 103(a) as being obvious over Kloba, et al., WO 01/18688 (Kloba).

Re the Specification:

The specification is amended to correct a minor typographical error. No new matter is added.

Re the Claims:

Claims 1, 15, 24, and 26-28 are amended as indicated in the listing of the claims. Support for the amendments to the claims is contained throughout the specification and claims as originally filed and more specifically at, for example, page 4, line 32 through page 5, line 6; page 9, lines 17-30; page 10, line 18 through page 12, line 19, and Figures 2A and 2B. No new matter is added.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102 and 103

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986). Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech,

Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

5 The test for obviousness under 35 U.S.C. § 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. In re Donovan, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the
10 disclosures of the references. In re Rinehart, 189 USPQ 143, 146 (CCPA 1976). All limitations of the claims must be considered. In re Boe, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicants' teachings. In re Meng, 181 USPQ
15 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. In re
20 Lintner, 173 USPQ 560, 562 (CCPA 1972).

 A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one
25 reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Put somewhat differently, the fact that the
30 inventions of the references and of the applicants may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicants' claimed invention. In re Donovan, 184 USPQ 414, 420 (CCPA 1975).

35 A reference which teaches away from the applicants'

invention may not properly be used in framing a 35 U.S.C. §103 rejection of applicants' claims. See United States v. Adams, 148 USPQ 429 (1966).

Re the Section 102 Rejections:

5 The examiner rejected claims 1, 5, 14, 15, 23, 24, and 26-31 under 35 U.S.C. §102(a) as being anticipated by Rudd. However, the present invention defined by the claims was actually conceived before the October 9, 2001, filing date of the Rudd patent, followed by a diligent constructive reduction to practice
10 between October 9, 2001, the filing date of the Rudd patent, and December 3, 2001, the filing date of the present application. Therefore, the Rudd patent is unavailable as a reference and cannot be used to support the anticipation rejections under Section 102. In support hereof, applicant submits the attached
15 Rule 131 declaration of Steven G. Henry, the sole inventor.

Re the Section 103 Rejections:

 The examiner rejected claims 2-4, 6-13, 16-22, and 25 under 35 U.S.C. § 103(a) as being obvious over Kloba. Applicant notes that the examiner's rejections based on the Kloba reference alone
20 may be in error, in that the examiner at several places discusses both Kloba and Rudd. See, for examples, paragraphs 8, 13, and 20 of the office action. Therefore, it appears that the examiner intended to reject the claims over the combination of Kloba and Rudd.

25 However, the question of whether the examiner rejected the claims over Kloba alone or over Kloba in combination with Rudd is irrelevant in that Rudd is not available as a reference. With regard to the Kloba, amended claim 1 is not obvious over Kloba because Kloba fails to disclose or suggest a method that involves
30 at least receiving network data "when said appliance is in an inactive mode." To the contrary, the mobile device of Kloba appears to work in the opposite sense. That is, the mobile device receives data when in the active mode (i.e., when the user

initiates a synchronization session by placing the mobile device into an adapter that includes a sync button). See, for example, page 8, line 16 through page 9, line 4 and Figure 1H1. Because Kloba does not disclose or suggest at least this limitation of claim 1, claim 1 is not obvious over Kloba.

Claims 2-11, 13, and 14 are at least allowable over Kloba in that they depend from claim 1, which is allowable over Kloba.

Independent claim 15 is not obvious over Kloba in that Kloba does not disclose apparatus for displaying network data that includes program code for receiving network data when the appliance is in an inactive mode. The mobile device of Kloba works in the opposite sense. That is, Kloba's mobile device receives data in the active mode, e.g., when the user initiates a synchronization session by placing the mobile device in an adapter and pressing a sync button. Therefore, claim 15 is not obvious over Kloba.

Claims 16-23 are at least allowable over Kloba in that they depend from claim 15, which is allowable over Kloba.

Independent claim 24 is not obvious over Kloba because Kloba does not disclose or suggest a multifunction device that is operatively associated with a network that comprises program code for receiving network data when the multifunction device is in an inactive mode. Because Kloba teaches receiving network data during a synchronization operation, Kloba cannot be said to make obvious claim 24.

Claim 25 is at least allowable over Kloba by virtue of its dependency from claim 24, which is allowable over Kloba.

Claim 26 is not obvious over Kloba because Kloba fails to disclose or even suggest apparatus for displaying network data that includes at least means for receiving network data at an appliance when the appliance is in an inactive mode. Again, Kloba's mobile device receives data in an active mode, i.e., when the user initiates a synchronization session. Therefore, claim 26 is not prima-facie obvious over Kloba.

Claim 27 is not obvious over Kloba because Kloba does not

disclose or suggest a method for displaying network data that includes receiving network data when the multifunction device is in an inactive mode. Kloba's mobile device receives data when the device is in an active mode, i.e., during a synchronization session. Therefore, claim 27 is not made obvious by Kloba.

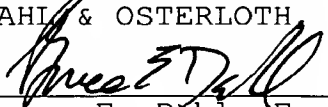
Claim 28 is allowable over Kloba because Kloba's mobile device receives data during a synchronization session, i.e., when the mobile device is in an active mode. Claim 28 is directed to apparatus for displaying network data that includes program code for receiving network data when the multifunction device is in an inactive mode. Because Kloba does not disclose or suggest at least this limitation, claim 28 is not obvious over Kloba.

Claim 29 is allowable over Kloba because Kloba does not disclose a method for displaying network data that includes receiving network data at an appliance having a paper handling function. Nowhere does Kloba disclose or suggest that his mobile device can have a paper handling function. Consequently, claim 29 is allowable over Kloba.

Claims 30 and 31 are allowable over Kloba at least by virtue of their dependency from claim 29, which is allowable over Kloba.

Applicant believes that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicant respectfully requests the examiner to reconsider the rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicant's attorney at the telephone number listed below.

Respectfully submitted,
DAHL & OSTERLOTH, L.L.P.



Bruce E. Dahl, Esq.
Attorney for Applicants
PTO Registration No. 33,670
555 17th Street, Suite 3405
Denver, CO 80202
(303) 291-3200

Date: 12-16-05